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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,258	10/21/2003	Oscar A. Chappel	92717-344USP1	3419
61060	7590	02/19/2009	EXAMINER	
WINSTEAD PC P.O. BOX 50784 DALLAS, TX 75201			LE, LINH GIANG	
			ART UNIT	PAPER NUMBER
			3686	
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			02/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,258	Applicant(s) CHAPPEL, OSCAR A.	
	Examiner MICHELLE LE	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>see continuation sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Attachments -- continuation of 3

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to application filed 21 October 2003.

Claims 1-22 remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8 are rejected under 35 USC 101 as these claims are directed to non-statutory subject matter. A claimed process is patent eligible under 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing. Independent claim 1 is directed towards a method of populating a knowledge base. There is no tie to a machine or apparatus in the body of the claim nor is there a transformation of a particular article towards a different state or thing. Thus the claims are directed towards a patent-ineligible process under 35 USC 101. Furthermore, a nominal recitation in the preamble of structure in an otherwise ineligible method fails to make the process statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by McIntosh (2002/0128874).

6. As per claim 1, McIntosh teaches a method of populating a knowledge base, the method comprising:
creating at least one claim element based on information related to at least one of a claim form and an updated specification (McIntosh; paras. 18, 31);
creating at least one rule from said information related to at least one of a claim form and an updated specification (McIntosh; paras. 31-32);
applying said at least one rule to said at least one claim element to form knowledge (McIntosh; paras. 18-20); and
populating the knowledge base with said knowledge acquired from said applying step (McIntosh; paras. 18-20).

Art Unit: 3686

7. As per claim 2, McIntosh teaches further comprising translating an edit to yield a translated edit, the translated edit being utilized in the step of creating the at least one claim element (McIntosh; para 33).

8. As per claim 3, McIntosh teaches further comprising binding at least one conclusion variable responsive to the applying step (McIntosh; para. 26).

Examiner submits that the phrase “reject the claim” reads upon a “conclusion variable.”

9. As per claim 4, McIntosh teaches wherein the step of creating the at least one claim element comprises:

creating at least one attribute (McIntosh; paras. 31 and 32); and

assigning at least one value to said attribute (McIntosh; paras. 31 and 32).

10. As per claim 5, McIntosh teaches further comprising validating a claim using appropriate claim-element knowledge in the populated knowledge base (McIntosh; para. 24).

11. As per claim 6, McIntosh teaches wherein the step of creating at least one claim element comprises the steps of:

creating at least one reference claim element (McIntosh; paras. 20-24); and

creating at least one reported claim element (McIntosh; paras. 20-24).

Art Unit: 3686

12. As per claim 7, McIntosh teaches further comprising the step of validating a claim by comparing said at least one reported claim element to said at least one reference claim element (McIntosh; para. 24).

13. As per claim 8, McIntosh teaches further comprising the step of verifying that the translated edit has been correctly translated (McIntosh; paras. 26-29).

14. As per claim 9 McIntosh teaches article of manufacture for populating a knowledge base used in validating medical claims, the article of manufacture comprising:
at least one computer readable medium;
processor instructions included on the at least one computer readable medium, the processor instructions configured to be readable from the at least one computer readable medium by at least one processor and thereby cause the at least one processor to operate as to (McIntosh; para. 17):
create at least one claim element based on information related to at least one of a claim form and an updated specification (McIntosh; paras. 18, 31);
create at least one rule from said information related to at least one of a claim form and an updated specification (McIntosh; paras. 31-32);
apply said at least one rule to said at least one claim element to form knowledge (McIntosh; paras. 18-20);
and populate the knowledge base with said knowledge acquired from said applying step (McIntosh; paras. 18-20).

Art Unit: 3686

15. Claims 10-14 repeat substantially similar limitations of claims 2-8 and thus the reasons for rejections are incorporated herein.

16. Claims 15-22 repeat substantially similar limitations of claims 9-14 and thus the reasons for rejection are incorporated herein.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571)272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on 571-272-3600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3686

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./
Examiner, Art Unit 3686
2/15/09

/C. LUKE GILLIGAN/
Supervisory Patent Examiner, Art Unit